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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/593,903

07/23/2007

Tokuji Oda

P71395US0

5794

136 7590 03/27/2012

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EXAMINER

PATTERSON, MARC A

ART UNIT

PAPER NUMBER

1782

MAIL DATE

DELIVERY MODE

03/27/2012

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/593,903	Applicant(s) ODA ET AL.	
	Examiner MARC PATTERSON	Art Unit 1782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2012.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 36-39 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 36-39 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

NEW REJECTIONS

Claim Rejections – 35 USC § 102(b)

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 36 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Imasaki et al (U.S. Patent Application Publication No. 2003/0094209 A1).

With regard to Claims 36 and 38, Imasaki et al discloses a tube by electroforming produced by forming an electrodeposit around a thin wire material and removing the thin wire (paragraph 0055), therefore providing a fine diameter; the tube comprises layers having different conductivity (paragraph 0064); the layers are metal (paragraph 0064), and the layers are therefore plated, because they are electrodeposited; the claimed aspects of the pulling of the wire deforming the material and electrodeposition are directed to process limitations and are therefore given little patentable weight. The claimed aspect of the tube being ‘for a contact probe’ is directed to an intended use and is therefore given little patentable weight. Imasaki et al fail to disclose a conductive layer having a higher electrical conductivity than the outer layer and thickness of the outer layer of 5 to 50 microns. However, as stated above, Imasaki et al disclose layers having different conductivity, and Imasaki et al disclose the selection of thickness depending on the desired use of the end product (paragraph 0065). It therefore would have been obvious for one of ordinary skill in the art to provide, through routine experimentation, a

thickness and conductivity depending on the desired use of the end product as taught by Imasaki et al.

Claim Rejections – 35 USC § 103(a)

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imasaki et al (U.S. Patent Application Publication No. 2003/0094209 A1).

With regard to Claims 37 and 39, Imasaki et al fail to disclose a diameter of 10 to 85 microns. However, Imasaki et al disclose the selection of diameter depending on desired use of the end product (diameter of 127 - 129 microns is only one embodiment; paragraph 0052). It therefore would have been obvious for one of ordinary skill in the art to provide, through routine experimentation, a diameter depending on the desired use of the end product as taught by Imasaki et al.

ANSWERS TO APPLICANT'S ARGUMENTS

5. Applicant's arguments regarding the rejections of the previous Action have been carefully considered but have not been found to be persuasive for the reasons set forth below.

Applicant argues, on page 5 of the remarks dated March 21, 2012, that the claimed thickness of the layers is necessary for use for a contact probe.

However, the reason for necessity of a particular thickness is unclear; furthermore, as stated above, intended use is given little patentable weight.

Applicant also argues, on page 6, that the claimed diameter is necessary for a contact probe, and that it would not be obvious to select the claimed diameter because Imasaki et al is used for a different purpose.

However, as stated above, intended use is given little patentable weight; furthermore it is unclear why Imasaki et al would be unusable for a contact probe.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc A Patterson whose telephone number is 571-272-1497.

The examiner can normally be reached on Mon - Fri 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Marc A Patterson/
Primary Examiner, Art Unit 1782